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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91206921
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**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Rich Products Corporation,

Opposer,

v.

VegiPro Brands, LLC,

Applicant.

Opposition No. 91206921

Application Serial No. 85/577,551

Mark: BETTER ON TOP!

**APPLICANT VEGIPRO BRANDS, LLC'S SUPPLEMENTAL ACR BRIEF**

**I. INTRODUCTION**

The term TOP is widely adopted by third parties for whipped topping products. Opposer Rich Products Corporation's ("Opposer") already co-exists with marks much more similar to its ON TOP mark than Applicant VegiPro Brands, LLC's ("Applicant") BETTER ON TOP! mark, such as TOPS. And this past July and August, the Federal Circuit issued its precedential *Juice Generation* and *Jack Wolfskin* decisions in which it stressed that, if there are similar marks being used by third parties (i.e., a crowded field), the existence of a crowded field may by itself obviate any likelihood of confusion. This is doubly true when the mark at issue is quintessentially descriptive like Opposer's ON TOP mark. In situations such as these, the addition of a single word is sufficient to preclude any likelihood of confusion. Applicant's addition of the word BETTER at the beginning of its mark and an exclamation point at the end is more than enough prevent any likelihood of confusion and merit the dismissal of Opposer's opposition, especially considering the difference in the parties' goods, trade channels, and customers.

## **II. RELEVANT BACKGROUND**

The relevant background is set forth in Applicant's summary judgment opposition brief. The only additional events that have occurred since Applicant's opposition brief consist of the Board's denial of Opposer's motion for summary judgment on at least the grounds of dissimilarity of marks and the number and nature of similar marks, as well as the parties' subsequent agreement to have this opposition determined through the ACR process.

## **III. LEGAL STANDARD IN AN ACR PROCEEDING**

In a trademark opposition proceeding asserting likelihood of confusion under § 2(d), the opposer bears the burden of proving its claim of likelihood of confusion by a preponderance of the evidence. *Cunningham v. Laser Golf Corp.*, 222 F.3d 943, 951 (Fed. Cir. 2000). And the standards of proof remain the same in an ACR proceeding. TBMP § 702.04(a). Therefore, an opposer in an ACR proceeding still has to establish its case by a preponderance of the evidence. *Id.*

## **IV. ARGUMENT**

For an opposer to prevail on summary judgment on a § 2(d) likelihood of confusion claim, the opposer must demonstrate by a preponderance of the evidence that the opposer has priority of rights<sup>1</sup> and that the use of the parties' respective marks would be likely to cause confusion, mistake, or deceive consumers. *GTFM, Inc. v. Fresh Body, LLC*, 2015 TTAB LEXIS 13, at \*11 (TTAB 2015). Moreover, the consideration of likelihood of confusion on summary judgment requires "an analysis of all the probative facts in evidence that are relevant to the thirteen factors set forth in *In re E.I. du Pont de Nemours & Co*" (the "*du Pont* factors"). *Id.* The 13 *du Pont* factors that need to be considered are as follows: (1) the similarity or dissimilarity of the marks in their entirety as to appearance, sound, connotation, and commercial impression; (2) the similarity or dissimilarity and nature of the goods or services; (3)

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<sup>1</sup> Priority is not at issue in this opposition.

the similarity or dissimilarity of established, likely-to-continue trade channels; (4) the conditions under which and buyers to whom sales are made, i.e. “impulse” vs. careful, sophisticated purchasing; (5) the fame of the prior mark; (6) the number and nature of similar marks in use on similar goods; (7) the nature and extent of any actual confusion; (8) the length of time during and conditions under which there has been concurrent use without any evidence of actual confusion; (9) the variety of goods on which a mark is or is not used (house mark, “family” mark, product mark); (10) the market interface between applicant and the owner of a prior mark; (11) the extent to which a party has the right to exclude others from use of its mark on its goods; (12) the extent of potential confusion, i.e., whether de minimus or substantial; and (13) any other established fact probative of the effect of use. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973).

As discussed below, the existence of a crowded field for TOP marks for whipped topping (factor #6) and the dissimilarity of marks (factor #1) are determinative that there is no likelihood of confusion between Applicant’s BETTER ON TOP! mark and Opposer’s weak, descriptive ON TOP mark.

**A. The Crowded Field of TOP Marks for Whipped Topping Goods Obviates a Likelihood of Confusion—Especially After the New *Juice Generation* Case**

The sixth *du Pont* factor requires the Board to consider the “number and nature of similar marks in use on similar goods.” *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). When there are many similar marks in use on similar goods or services, the mark is considered weak and “merely one of a crowd of marks.” *One Industries, LLC v. Jim O’Neal Distributing, Inc.*, 578 F.3d 1154, 1164 (9th Cir. 2009). This is known as a crowded field. *Id.* When a mark exists in a crowded field, the public is presumed to be able to distinguish the mark from other marks that may have only minor differences. *King Candy Co. v. Eunice King’s Kitchen Inc.*, 182 U.S.P.Q. 108 (C.C.P.A. 1974) (“confusion is unlikely because the marks are ... so widely used that the public easily distinguishes slight differences in the marks as well as

differences in the goods ...”); *Jupiter Hosting Inc. v. Jupitermedia Corp.*, 76 U.S.P.Q.2d 1042 (N.D. Cal. 2004); *In re Hamilton Bank*, 222 U.S.P.Q. 174, 179 (T.T.A.B. 1984).

Moreover, the Federal Circuit recently clarified that the Board may not simply ignore evidence of a crowded field and must give due consideration and weight to the significance of such evidence. *Juice Generation, Inc. v. GS Enterprises LLC*, 2015 U.S. App. LEXIS 12456, \*7-12 (Fed. Cir. July 20, 2015); *Jack Wolfskin Ausrüstung Fur Draussen GmbH & Co. KGAA v. New Millennium Sports, SLU*, 2015 U.S. App. LEXIS 14514, \*18-23 (Fed. Cir. Aug. 19, 2015). In *Juice Generation*, the Federal Circuit reversed the Board’s decision sustaining an opposition because the Board failed to properly consider Juice Generation’s crowded field evidence. *Juice Generation*, 2015 U.S. App. LEXIS 12456, at \*7-12. In doing so, the Federal Circuit held that evidence of many similar registered marks is “powerful on its face” and the Board may not simply disregard evidence of third party registrations just because there may not be additional evidence regarding the use, sales, and promotional efforts of the registered marks in the marketplace:

The "specifics" as to the extent and impact of use of the third parties' marks may not have been proven, but in the circumstances here, Juice Generation's evidence is nonetheless *powerful on its face*. The fact that a considerable number of third parties use similar marks was shown in uncontradicted testimony. In addition, “[a] real evidentiary value of third party registrations per se is to show the sense in which . . . a mark is used in ordinary parlance.” 2 McCarthy on Trademarks and Unfair Competition § 11:90 (4<sup>th</sup> ed. 2015) (emphasis added). “Third party registrations are relevant to prove that some segment of the composite marks which both contesting parties use has a normally understood and well-recognized descriptive or suggestive meaning, leading to the conclusion that that segment is relatively weak.” *Id.*; see *Tektronix, Inc. v. Daktronics, Inc.*, 534 F.2d 915, 917 (CCPA 1976) (even if “there is no evidence of actual use” of “third-party registrations,” such registrations “may be given some weight to show the meaning of a mark in the same way that dictionaries are used”). Marks that are descriptive or highly suggestive are entitled to a narrower scope of protection, *i.e.*, are less likely to generate confusion over source identification, than their more fanciful counterparts. See, e.g., *Nat’l Data Corp. v. Computer Sys. Eng’g, Inc.*, 940 F.2d 676, *Id.* at \*2 (Fed. Cir. 1991) (unpublished); *Drackett Co. v. H. Kohnstamm & Co.*, 404 F.2d 1399, 1400, 56 C.C.P.A. 852 (CCPA 1969) (“The scope of protection afforded such highly suggestive marks is necessarily narrow and confusion

is not likely to result from the use of two marks carrying the same suggestion as to the use of closely similar goods.”).

*Id.* at \*9-10. Removing any doubt about the importance of crowded field evidence, the Federal Circuit again reversed the Board in *Jack Wolfskin* for failing to properly consider such evidence in accordance with its decision in *Juice Generation*:

We agree with Jack Wolfskin that the Board erred in its consideration of this evidence. Jack Wolfskin presented extensive evidence of third-party registrations depicting paw prints and evidence of these marks being used in internet commerce for clothing. The Board too quickly dismissed the significance of this evidence. As we recently explained in *Juice Generation*, such extensive evidence of third-party use and registrations is "powerful on its face," even where the specific extent and impact of the usage has not been established.

*Jack Wolfskin*, 2015 U.S. App. LEXIS 14514, at \*20-21. Accordingly, pursuant to binding Federal Circuit precedent, the Board must give serious consideration and weight to evidence of a crowded field.

In the instant case, the crowded field of TOP marks for whipped topping goods obviates any likelihood of confusion and is dispositive in itself. As an initial matter, Applicant incorporates all of its arguments on this issue contained in its summary judgment opposition brief. Furthermore, Applicant notes that the Federal Circuit’s decisions in *Juice Generation* and *Jack Wolfskin* were issued after the parties briefed Opposer’s motion for summary judgment and after the Board’s decision denying Opposer’s smotion for summary judgment. Now, in light of these decisions by the Federal Circuit, Applicant respectfully submits that the crowded field of TOP marks for whipped cream requires a finding that there is no likelihood of confusion. As detailed in Applicant’s summary judgment opposition, there are several marks for TOP for whipped topping:

Mark	Relevant Goods	Registration Number
VELVETOP	Non-dairy based whipped toppings, in Class 29	4,338,749
HEALTHY TOP	Non-dairy based whipped toppings, in Class 29	4,201,737
FRUTOP	Whipped cream, in Class 29	3,838,830
TOP 'N FILL	Whipped non-dairy topping, in Class 29	2,243,704
TOPS	Whipped topping, in Class 29	2,963,913
TOPS	Non-dairy whipped topping, in Class 29	1,433,101
TOP FROST	Frozen non-dairy whipped topping, in Class 29	1,392,524
HY-TOP	Frozen whipped topping, in Class 29	1,120,324

Copies of these registrations were attached to the Declaration of Bruno Tarabichi accompanying Applicant's summary judgment opposition brief. Notably, in *Jack Wolfskin*, the Federal Circuit found the crowded field determinative of the likelihood of confusion inquiry: "we conclude that the dissimilarity of marks and many third-party marks incorporating the paw prints requires us to find that there is no likelihood of confusion." *Jack Wolfskin*, 2015 U.S. App. LEXIS 14514, at \*23. Likewise, the descriptive phrase ON TOP coupled with the crowded field of TOP marks for whipped topping (the very goods at issue) proves that (i) Opposer's mark is very weak and entitled to only narrowest protection, (ii) consumers are accustomed to distinguishing between marks consisting of TOP for whipped topping, and (iii) there is simply no likelihood of confusion (as the Examining Attorney found when Applicant's mark was allowed).

**B. In Light of the Crowded Field, Applicant's BETTER ON TOP! Mark Is Sufficiently Dissimilar from Opposer's ON TOP Mark to Obviate Any Likelihood of Confusion**

In order to determine whether there is a likelihood of confusion due to the similarity of the marks, the marks must be compared in terms of appearance, sound, connotation, and overall commercial impression. *Joel Gott Wines, LLC v. Rehoboth Von Gott, Inc.*, 107 USPQ2d 1424, 1429-1430 (TTAB 2013). Considering the crowded field of TOP marks, when Applicant's BETTER ON TOP! mark is compared to Opposer's RICH'S ON TOP and ON TOP marks in terms of appearance, sound, connotation, and overall commercial impression, the dissimilarities are more than sufficient to obviate any likelihood of confusion.

**1. The Marks Are Dissimilar in Appearance**

In Applicant's summary judgment opposition, Applicant noted that applicable case law holds that even if two marks share a common word, an additional word(s) is sufficient to avoid a likelihood of confusion. *See* cases cited in Applicant's opposition brief. In the instant case, Applicant's BETTER ON TOP! begins with the word BETTER, which is the first word any consumer would see. Likewise, Applicant's BETTER ON TOP! mark ends with an exclamation point, which is visually memorable. In contrast, Opposer's mark does not contain any word similar to BETTER and does not contain any punctuation. Moreover, Opposer always couples ON TOP with its house mark RICH'S, which further distinguishes the marks.

**2. The Marks Are Dissimilar in Sound**

In Applicant's summary judgment opposition, Applicant cited cases holding that, if the first word of the marks sound dissimilar, then the marks sound dissimilar and there is less likelihood of confusion. In the instant case, the first words of the mark sound completely different (BETTER v. ON), and as a result, there is no likelihood of confusion.



### **3. The Marks Are Dissimilar in Connotation**

In Applicant's summary judgment opposition, Applicant explained, and submitted evidence, that Applicant's BETTER ON TOP! mark is a double entendre play on words and a sexual innuendo that slyly references a sexual position in which the female partner is on top of the male partner, whereas Opposer's ON TOP mark conveys nothing more than the fact that whipped toppings are generally placed on top of a food item. As such, there is no likelihood of confusion.

### **4. The Marks Are Dissimilar in Commercial Impression**

Applicant's BETTER ON TOP! mark creates a commercial impression that is separate and different because the additional term BETTER coupled with the exclamation point, the clear phonetic difference created by the first word BETTER, and the sexual innuendo implied by BETTER ON TOP! create a commercial impression that is unique and that obviates any likelihood of confusion.

### **C. There Are Additional *du Pont* Factors That Weigh Against Any Likelihood of Confusion**

Although Applicant respectfully submits that the dissimilarity of the parties' marks and the existence of a crowded field of TOP marks are sufficient to conclude that there is no likelihood of confusion, Applicant reasserts that there are additional *du Pont* factors that weigh against any likelihood of confusion. In this regard, Applicant briefly reiterates these factors but directs the Board to a full discussion of each factor in Applicant's summary judgment opposition.

#### **1. Applicant's Goods Are Distinguishable From Opposer's Goods**

As detailed in Applicant's summary judgment opposition, Applicant's whipped topping product is actually significantly different from Opposer's non-dairy whipped topping product because Applicant's product is a completely organic, vegan whipped topping whereas Opposer's product, on the other hand, is not organic and is not vegan because it contains a milk derivative and high fructose corn syrup. Importantly, the supplemental evidence submitted by Opposer

with its ACR brief underscores this point, as the evidence shows that Opposer's product contains a milk derivative and that Opposer has no vegan whipped topping offerings.

## **2. The Parties Use Dissimilar Trade Channels**

As analyzed in Applicant's summary judgment opposition, Applicant's BETTER ON TOP! brand whipped topping travels through trade channels that are completely different from the trade channels used by Opposer's ON TOP whipped topping. Applicant's BETTER ON TOP! product will be distributed to, and sold by, organic natural foods retailers whereas Opposer's ON TOP product is only sold directly to food service industry businesses, such as restaurants, hotels, bakeries, and caterers. As a result, the parties' products will never appear side by side on a shelf. *Id.* And because Applicant does not, and will not, sell directly to the food industry, it is impossible for restaurants, hotels, bakeries, or caterers to accidentally or mistakenly purchase Applicant's product instead of Opposer's product. Importantly, the supplemental evidence submitted by Opposer with its ACR brief underscores this point, as the evidence shows that Opposer sells its product directly to the food industry only.

## **3. The Conditions Under Which and Buyers to Whom Sales Are Made Preclude Any Likelihood of Confusion**

The fourth *du Pont* factor considers the conditions under which and the buyers to whom sales are made (i.e., impulse versus careful, sophisticated purchasing). *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). If the goods at issue are being sold to unsophisticated purchasers or if the goods are typically impulse purchases, then that weighs in favor of likelihood of confusion. However, if the goods at issue are being sold to sophisticated purchasers or if the goods are purchased in a careful manner, then that weighs against a likelihood of confusion. *Id.*

In the instant case, both Applicant's goods and Opposer's goods are sold to sophisticated purchasers. Opposer sells its good directly to businesses in the food service industry, such as restaurants, hotels, and caterers. These are sophisticated business purchasers. Applicant also

sells (or will sell) its goods to sophisticated business purchasers, namely, organic, natural food retailers. Moreover, vegans are notoriously careful in making their food selections. Because both parties sell to sophisticated purchasers and because the sales process does not involve impulse purchasing, this *du Pont* factor weighs against a likelihood of confusion.

#### **4. Opposer's Mark Is Not Famous**

The fifth *du Pont* factor consider the fame of opposer's mark. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). If the opposer's mark is famous, then this factor weighs in favor of opposer. *Id.* Otherwise, if the opposer's mark is not famous, then this factor weighs in favor of applicant. *Id.* In this regard, the TTAB has repeatedly held that simply asserting that a party has significant sales or advertising expenditures is insufficient to prove fame under the fifth *du Pont* factor. *Cognis Corp. v. HANA Co. Ltd.*, 2007 TTAB LEXIS 117, \*43-44 (TTAB 2007); *Board of Regents v. Southern Illinois Miners, LLC*.

In the instant case, Opposer has not submitted any evidence proving that its ON TOP trademark is famous. Rather, Opposer only argues that the mark has been used for a long time and that sales under the mark have been significant. But, per *Cognis*, this is insufficient for fame. Accordingly, Opposer has not proven by a preponderance of the evidence that its mark is famous, and this fifth *du Pont* factor weighs in Applicant's favor and against any likelihood of confusion.

#### **5. The Extent of Potential Confusion Is Minimal**

The twelfth *du Pont* factor considers the extent to which any potential confusion will be de minimis or substantial. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). If the potential confusion is de minimis (i.e., minimal) as opposed to substantial, then this factor weighs against a likelihood of confusion. *Id.* In the instant case, any potential confusion would be de minimis because (i) vegan consumers will not accidentally purchase a non-vegan whipped topping containing GMOs, (ii) the parties marks are different, (iii) the parties use different trade channels and sell to different types of purchasers, and (iv) Opposer's marks

already co-exist with more similar marks for whipped toppings. Accordingly, this factor weighs in Applicant's favor and against a likelihood of confusion.

**6. There Is No Likelihood of Confusion Due to Opposer's Consistent Use of Its House Mark**

The thirteenth *du Pont* factor permits the parties to submit any other probative facts or arguments that are relevant to the issue of likelihood of confusion. *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357, 1361 (CCPA 1973). In the instant case, Opposer always uses its ON TOP trademark with the word RICH'S and, in particular, with the red RICH'S logo:



. This fact is evident by Opposer's own evidence with the original motion for summary judgment, as well as the supplemental evidence submitted with its ACR brief. As such, consumers are always know that Opposer's goods are being sold by Opposer, and this thirteenth *du Pont* factors weighs in Applicant's favor and against a likelihood of confusion

**V. CONCLUSION**

For all the foregoing reasons, Applicant respectfully submits that there is no likelihood of confusion between Opposer's ON TOP mark and Applicant's BETTER ON TOP! Mark and, therefore, respectfully requests that the Board dismiss Opposer's opposition.

Dated: October 19, 2015

Respectfully submitted,

A handwritten signature in black ink, appearing to read "Bruno W. Tarabichi".

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## **CERTIFICATE OF SERVICE**

I hereby certify that a true and complete copies of the following documents:

### **APPLICANT VEGIPRO BRANDS LLC'S SUPPLEMENTAL ACR BRIEF**

has been served on

Brian E. Turung  
Sandra M. Koenig  
Fay Sharpe LLP  
1228 Euclid Ave.  
The Halle Bldg., 5<sup>th</sup> Floor  
Cleveland, Ohio 44115

by emailing such document on October 19, 2015 pursuant to the parties' written agreement to service by email.

I declare under penalty of perjury under the laws of the State of California and the United States of America that the foregoing is true and correct.

Dated: October 19, 2015



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Bruno W. Tarabichi